

## **REMARKS / ARGUMENTS**

The present application includes pending claims 1-31, all of which have been rejected. Claims 1, 5-11, 15-21, and 25-30 have been amended. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-5, 8-15, 18-25, and 28-31 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2002/0104099 ("Novak"). Claims 6, 7, 16, 17, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Novak, in view of U.S. Patent No. 7,174,512 ("Martin"). The Applicant respectfully traverses these rejections at least based on the following remarks.

### **I. Examiner's Response to Arguments**

#### **A. Section 7 (pages 3-5 of the Office Action)**

The Examiner states the following in the "Response to Arguments" section of the Office Action:

The Examiner additionally submits that Upload Source 122 is equated to Applicant's "first location" and STS 152 is equated to Applicant's "second location" in order to establish points of reference in addressing the limitation "transparently transferring from said first location... to at least a second location" using Novak method of Figs. 4 and 11. The Examiner presents that Novak defines Upload Source 122 to function as an "individual" or an "organization" (Paragraph [0039]), a "consumer" (Paragraph [0056]), and "can comprise or can use a set top box, a PC, or other access device..." Paragraph [0056]). It is the Examiner's position that Upload Source 122 is structurally and functionally equivalent to the STS 152 based on Novak's disclosure Paragraphs [0039,0056]. Therefore, Upload Source 122, which can comprise a set top box, also

views and interacts with EPG 153 containing a plurality of channels shown as Television Channels 902 and synthetic channel Listing 908. In order to further clarify this position, this Office Action addresses Applicant's "first location" as "uploading individual at Upload Source 122" and Applicant's "second geographic location" as "client terminal of end user at STS 152", which is in accordance with Novak's Figs. 4 and 11, as described in Paragraphs [0056-0060 and 0078-0086].

See the Office Action at page 4. The Applicant respectfully disagrees with the above arguments. The Examiner is primarily relying for support on paragraph 0039 of Novak, which discloses that the upload source 122 can include an individual or organization that uses a device, such as a set-top box, a PC or another device, to upload information. The Examiner then alleges that the upload source 122 is "structurally and functionally equivalent to the STB 152 based on Novak's disclosure in paragraphs 0039 and 0056." **The Applicant respectfully disagrees and submits that there is absolutely no support in Novak for such alleged structural and functional equivalence. On the contrary, Novak very clearly describes that the upload source 122 and the STB 152 at the end user location are not only at separate geographic locations, but they also perform specific and separate functionalities.** For example, regardless of the fact that the upload source 122 can include an individual or organization that uses a set-top box, such individual or organization uses the set-top box (at the first geographic location) **only "to make information available via the Internet".** In other words, **Novak discloses that the functionality of the upload**

**source 122 (at the first geographic location) is to only upload information and make it available via the Internet to other users.**

In addition, based on the above Office Action citation, the Examiner has now changed his argument to "clarify" his position and has equated Applicant's "first geographic location" to Novak's "uploading individual at upload source 122." The Applicant respectfully disagrees and points out that **an "uploading individual" is not a "geographic location."** Therefore, the Applicant submits that the introduction of the "uploading individual" does not have any relevance for purposes of the 35 U.S.C. § 102(e) rejection under Novak. The Examiner has already clearly stated and acknowledged, in the above Office Action citation, that it is the Upload Source 122 that is equated to Applicant's "first location".

As already explained in the September 2, 2008 response, FIGS. 4 and 11 relate to the functionalities of the server 124. The Applicant fails to see the relevance of Novak's citation that "other types of tools or applications may be used in addition to or instead of a web-based application." Also, user interface 702 of FIG. 7 is explained with reference to the STB 504, which in turn is also related to the functionalities of the server 124. There is simply no support in Novak that the upload source 122 performs any functionality other than what is already specifically described by Novak, namely, media uploading functionality. The synthetic channel is organized at the location of server 124, not the uploader 122.

**B. Section 9 (pages 5-6 of the Office Action)**

With regard to the “transparently transferring” limitation, the Examiner is relying for support on the last sentence of paragraph 0068 of Applicant’s specification. The Applicant respectfully disagrees and points out that **even if “Mom” gives an authorization to “Brother” to perform transparent media transfers, this does not mean that “Mom” will be aware exactly when the act of transparent media transferring will take place.** There is no such disclosure and none can be inferred from paragraph 0068 of the specification. The last sentence of paragraph 0068 of Applicant’s specification merely states that “Mom” may authorize “Brother” to perform transparent media transfers to “Mom’s House” from “Brother’s House”. Therefore, contrary to the Examiner’s assertion in page 6 of the Office Action, “transparent transferring” excludes user awareness in the reception of transferred media (how else would the media transfer be a “transparent” media transfer).

**C. Section 11 (pages 6-7 of the Office Action)**

The Examiner states the following in the Office Action:

The Examiner submits that Claims 1, 11, or 21 do not require "television broadcast programming" to be transfer from a first location to a second location. It is the Examiner's position that *Novak's teachings of uploading personal media is sufficient to met the Claim 1 limitation "at least a portion*

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*of said organized channels to at least a second location".* The Examiner further submits that Applicant's Specification does not provide sufficient evidence to support the transfer of "mass-communicated" broadcast media.

See the Office Action at pages 6-7 (emphasis added). The Applicant points out that the relevant claim limitation that was being analyzed by the Applicant is "organizing, at said first location, said located media and at least a portion of broadcast media into channels," which is the second sub-clause of claim 1, not the third sub-clause (used by the Examiner in the above citation). The important point here is that the "located media" and "broadcast media" are being organized at the first location, with Novak not disclosing the broadcast media aspect with respect to the first location (server 124).

The Applicant respectfully disagrees with the overly broad interpretation of "broadcast media", which, according to the Examiner, also includes personal video recordings. The term "broadcast" has a specific meaning in the art, and is normally associated with mass communication of television programs by broadcast television stations and/or cable providers. To further clarify the term, the Applicant has amended the above claims to recite "television broadcast media." Support for such claim amendment may be found in, for example, paragraph 47 of the specification. As explained in the September 2, 2008 response, Novak provides television broadcast media separately and only via the cable service provider 108 over the cable network 134 (however, not together with the personal media in one channel).

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The Applicant respectfully maintains all arguments stated in the September 2, 2008 response.

## **REJECTION UNDER 35 U.S.C. § 102**

### **II. Novak Does Not Anticipate Claims 1-5, 8-15, 18-25, and 28-31**

The Applicant now turns to the rejection of claims 1-5, 8-15, 18-25, and 28-31 under 35 U.S.C. 102(e) as being anticipated by Novak. With regard to the anticipation rejections under 102, MPEP 2131 states that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See id. (internal citation omitted).

Without conceding that Novak qualifies as prior art under 35 U.S.C. 102(e), the Applicant respectfully traverses this rejection as follows.

#### **A. Rejection of Independent Claim 1 under 35 U.S.C. § 102(e)**

With regard to the rejection of independent claim 1 under 102(e), the Applicant submits that Novak does not disclose or suggest at least the limitation of “organizing, at

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said first geographic location, said located media and at least a portion of television broadcast media into channels," as recited by the Applicant in independent claim 1.

The Office Action states:

With respect to Claim 1, the claimed "locating media stored locally at least at a first location in the communication network; organizing, at said first location, said located media and at least a portion of broadcast media into channels" is met by the Novak reference that teaches an uploading individual at upload source 122 organizing media by way of User Interface 702 of Fig. 7 for presentation within EPG 153 of Fig. 9, which is viewable by way of a set top box device (Figs. 1, 4, 7, 9, and 11; paragraphs 0010, 0026, 0039, 0041, 0056-0060, 0063, and 0078-0086).

See the Office Action at page 8. Initially, the Applicant points out that none of the cited paragraphs (paragraphs 0010, 0026, 0039, 0041, 0056-0060, 0063 & 0078-0086), or any remaining paragraphs of Novak, disclose that the upload source 122 communicates media files to the local studio 106. Only paragraph 0041 of Novak discloses that the upload source 122 can have an agreement with the local studio 106 and notify studio 106 of the web address of web site 124, which maintains the uploaded media for the synthetic channel. In this regard, the cable subscribers can be provided with media programs from the server or web site 124. Notwithstanding, the Applicant points out that none of the data that is uploaded by the upload source 122 to the server or web site 124 includes any broadcast programming. The Applicant also points out that **an “uploading individual” is not a “geographic location.”** Therefore, the Applicant submits that the introduction of the “uploading individual” does not have any relevance for purposes of the 35 U.S.C. § 102(e) rejection under Novak.

Referring to FIG. 1 of Novak, the Applicant points out that the upload source 122 can upload media to the web site or server 124. See Novak at ¶¶ 0040-0041. In addition, the uploaded media may include personal media or recorded clips of TV programs, as described in more detail in ¶ 0039 of Novak. **However, the media uploaded to server 124 does not include any television broadcast programming (the Applicant notes that recorded clips of TV programs do not constitute broadcast media as the video clips are personal recordings that are not being broadcast, i.e., mass-communicated).** As seen from Novak's FIG. 1, such **broadcast media is provided separately by the cable service provider 108 over the cable network 134 and it is not provided together with the personal media in one channel.**

Furthermore, the Applicant points out that the server 124 (and not the uploader 122) stores the media for the synthetic channel. Obviously, the Examiner, in the Office Action, is equating Applicant's "first location" to Novak's location of server 124. Furthermore, the personal media uploaded by uploader 122 to server 124 is organized into a "synthetic channel" at the location of server 124. The Applicant also notes that the entire FIG. 4 of Novak relates to a method of providing media to the server 124, not the location of uploader 122, for purposes of organizing the "synthetic channel". The Applicant has clarified claims 1, 11, and 21, as set forth above, to emphasize that the channel organized at Applicant's "first location" is organized using the media located at

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the first location and broadcast media. Neither the location of server 124 nor the location of the local studio 106 (or even the location of the uploader 122) is used for purposes of organizing the synthetic channel to include the transferred personal media and broadcast programming.

In this regard, Novak does not disclose or suggest at least the limitation of "organizing, at said first geographic location, said located media and at least a portion of television broadcast media into channels," as recited by the Applicant in independent claim 1.

Furthermore with regard to the rejection of independent claim 1 under 102(e), the Applicant submits that Novak does not disclose or suggest at least the limitation of "transparently transferring from said first geographic location, at least a portion of said organized channels to at least a second geographic location within the communication network," as recited by the Applicant in independent claim 1.

The Office Action states:

The claimed "transparently transferring from said first location, at least a portion of said organized channels to at least a second location within the communication network" is met by the Novak reference that teaches client terminal of end user at STB 152 receiving media files associated with the 'synthetic' channel when it is selected for viewing- whereby a 'synthetic' channel is added to an user's EPG 153 at a 2nd location, via an emailed token or other electronic file, such as a Java applet that is automatically downloaded and triggers an update of EPG 153 (Figs. 1,2,4,9, 11; paragraphs 0041,0058, 0059, 0080, 0085, & 0086).

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See the Office Action at page 8. The Applicant respectfully disagrees with the above argument, especially the above bolded portion. Referring to FIG. 4 of Novak, the Applicant points out that at step 406, a token or electronic file is **sent to the end user** to subscribe the end user's terminal (set top box 152) to the synthetic channel. More specifically, Novak, at ¶ 0058, discloses that the individual (who uploads the media to server or web site 124) **emails the token or other electronic file to the end user**. Obviously, the user will be aware of such emailed token. In this regard, Novak also does not disclose that at least a portion of the channel itself is transparently transferred to at least a second location within the communication network, as recited in Applicant's claim 1. Furthermore, the Applicant submits that the fact that a token or an electronic file is transferred to effectuate subscription to the synthetic channel illustrates that the transfer of information is not transparent.

Accordingly, independent claim 1 is not anticipated by Novak and is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the reference cited in the Office Action at least for the reasons stated above with regard to claim 1.

**B. Rejection of Dependent Claims 2-5, 8-10, 12-15, 18-20, 22-25, and 28-31**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 102(e) as being anticipated by Novak has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-5, 8-10, 12-15, 18-20, 22-25, and 28-31 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-5, 8-10, 12-15, 18-20, 22-25, and 28-31.

**III. The Proposed Combination of Novak and Martin Does Not Render Claims 6, 7, 16, 17, 26, and 27 Unpatentable**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 102(e) as being anticipated by Novak has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Martin) does not overcome the deficiencies of Novak, claims 6, 7, 16, 17, 26, and 27 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also

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reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 6, 7, 16, 17, 26, and 27.

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**CONCLUSION**

Based on at least the foregoing, the Applicant believes that all claims 1-31 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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